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750Practitioner's Docket No. MB-1-CIP

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Application No.: 10 / 761,793 Group No.: 2873  
Filed: 1/20/2004 Examiner: H.X. Dang  
For: Novel Eyewear

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION FOR REVIVAL OF AN APPLICATION  
FOR PATENT ABANDONED UNINTENTIONALLY UNDER  
37 C.F.R. § 1.137(b)

NOTE: In a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995, any petition to revive pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any terminal disclaimer pursuant to this paragraph must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought. The provisions of this paragraph do not apply to lapsed patents. 37 C.F.R. § 1.137(d).

NOTE: In accordance with the Notice of November 5, 1990 (1121 O.G. 6), an application abandoned under 37 C.F.R. § 1.53(d) for failure to timely provide the appropriate filing fee, oath or declaration and/or surcharge may be revived under the procedure of 37 C.F.R. § 1.137(b).

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. \_\_\_\_\_ (mandatory)

## TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Date: 9/2/05

Signature

Fernando A. Borrego

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Petition for Revival of Unintentionally Abandoned Application [11-3]—page 1 of 3)

09/09/2005 MAILRE2 00000012 10761793

750.00 00P

01 FC:2453

1. This application became abandoned on April 28, 2005

NOTE: Extensions under 37 C.F.R. § 1.136 are available only if asked for "prior to or with the response." Accordingly, if the question of abandonment arises when the provisions of § 1.136 can no longer be used, then the application is abandoned when the unextended time for response expired. Therefore, no extension fees are due on a petition for revival. Thus: An application which is abandoned for failure to respond within a set period with no extension fee having been paid, would not require the payment of extension fees as a condition for revival. M.P.E.P. § 711.03(c), 6th ed., rev. 2.

2. This application became abandoned because the failure to prosecute was an unintentional delay. The entire delay in filing the required reply from the due date until the filing of this petition was unintentional 37 C.F.R. § 1.137(b)(3).

3. Response or action required

☐ has been filed.

☒ is attached.

(complete the following, if applicable)

NOTE: The PTO accepts the filing of a continuing application as a response under 37 C.F.R. 1.137. To facilitate processing in such a case, the petition to revive should specifically refer to the filing of a continuing application and also include an express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application. Notice of May 13, 1983, (1031 O.G. 11-12). See also M.P.E.P. § 711.03(c), 6th ed., rev. 2. "In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof." 37 C.F.R. § 1.137(b)(1).

☐ The response is the filing of a continuation application having an express abandonment conditioned on the granting of a filing date to the continuing application copending with this application.

4. Fee (37 C.F.R. 1.17(m))

Application status is:

☒ Small business entity—fee ~~\$665.00~~ \$750.00

☐ A statement is attached.

☐ A statement was filed.

☐ Other than small entity—fee \$1,330.00

5. Payment of fee

☒ Attached is a ☒ check ☐ money order in the amount of \$ 1260 (including ext. of time)

☐ Authorization is hereby made to charge the amount of

☐ \$665.00. ☐ \$1,330.00.

☐ to Deposit Account No. \_\_\_\_\_

☐ to Credit Card as shown on the attached credit information authorization form PTO-2038.

A duplicate of this petition is attached.

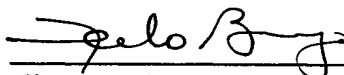
WARNING: Credit card information should not be included on this form as it may become public.

(Petition for Revival of Unintentionally Abandoned Application [11-3]—page 2 of 3)

(complete the following, if applicable)

- ☒ Because this petition is more than 3 months after the date the Office first notified the applicant that the application is abandoned, applicant additionally submits a showing as to how the delay between the date the applicant was first notified that the application is abandoned and the filing of this petition under 37 C.F.R. § 1.134(b) was unintentional. 62 Fed. Reg. 53,131, 53,159 (Oct. 10, 1997).
- ☐ Because this petition is more than 1 year after the date of abandonment of the application, applicant additionally submits further information as to when applicant (or applicant's representative) first became aware of the abandonment of the application, and a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative). 62 Fed. Reg. 53,131, 53,159 (Oct. 10, 1997).

Date: 9/2/05



Signature of person making statement  
that abandonment was due to an unintentional delay

Fernando A. Borrego  
(type or print name of person making statement)

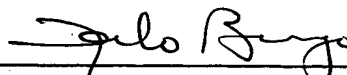
1238 Balfour St.  
Residence of person making statement

Grosse Pointe Park, MI 48230

Reg. No.: 34,780

Tel. No.: (734) 324-6193

Customer No.:



SIGNATURE OF PRACTITIONER

Fernando A. Borrego  
(type or print name of practitioner)

1238 Balfour Street  
P.O. Address

Grosse Pointe Park, MI 48230



**STATEMENT IN SUPPORT OF PETITION UNDER 37 CFR §1.137(b)**

I, Fernando A. Borrego, submit the following facts in support of the Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR §1.137(b):

1. During the period set by the United States Patent and Trademark Office (USPTO) for reply to the Non-Final Office Action issued in the subject patent application (Ser. No. 10/761,793, hereinafter "Subject Application") dated September 20, 2004, I, as Applicant's attorney of record, and Applicant (Michael J. Bleau) held substantive discussions regarding the manner and form of responding to the outstanding Non-Final Office Action. See attached copy of correspondence between Applicant and myself (Attachment A). The set of draft claims during this time frame were intended to focus on the embodiments of Figures 1-10 of the Subject Application.
2. In Attachment A, it is noted (see highlighted text) that I mistakenly identified January 20, 2005 as the date by which a Response to the Non-Final Office Action could be filed without an extension of time, thereby leading to the erroneous conclusion that such Response could be timely filed by April 20, 2005 with the appropriate three-month extension of time under 37 CFR §1.136(a).
3. I became cognizant of this error in fact after the actual final date upon which a timely Response could be filed (Monday, March 21, 2005) but before the anticipated/erroneous date (Wednesday, April 20, 2005), when on or about April 18, 2005, I realized the error while reviewing the Subject Application file and the outstanding Non-Final Office Action in connection with preparation of a Response

thereto. This error was confirmed when I received from the USPTO a Notice of Abandonment dated April 29, 2005, relating to the Subject Application.

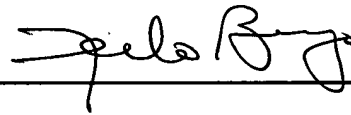
4. I promptly notified Applicant of these facts and, after conferring with Applicant and confirming his intention to continue the prosecution of the Subject Application, I undertook steps to prepare a Petition for Revival of the Subject Application and complete the Response to the outstanding Non-Final Office Action.

5. Shortly after receipt of a Notice of Allowance (see Attachment B) in the parent of the Subject Application (Ser. No. 10/205,238, hereinafter "Parent Application"), in early July 2005, I notified Applicant of this fact and conferred with him regarding the scope of the then proposed claimed subject matter for the Subject Application, the scope of the allowed claims in the Parent Application, and similarities and differences between the claims in the Subject Application and the Parent Application. It was determined that scope of the proposed claims for the Subject Application were too similar to the set of allowed claims in the Parent Application.

6. I promptly began preparing a revised set of claims for the Response intended to accompany the Petition for Revival of the Subject Application. The revised set of claims was drafted to focus on the embodiments of Figures 11-17. This, of course, required me to re-evaluate the prior art cited by the USPTO Examiner, elicit the differences between proposed claims and the prior art, and develop arguments for patentability of the new set of claims. Several conferences and discussions were required between Applicant and myself to this end.

7. It has never been the intention of Applicant or myself to abandon the prosecution of the Subject Application, and all action taken has been directed at furthering the prosecution of same with all due care and without unwarranted delay

8. Further, I affirm that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

A handwritten signature in black ink, appearing to read "F. Borrego", is written over a solid horizontal line.

Fernando A. Borrego

ATTACHMENT A



Michael Bleau  
<mbleau@industry-scope.com>

01/12/2005 05:44  
PM

To Fernando A  
Borrego/NOLWYANDOTT/BASF-CORP/BASF@BASF-CORP

cc

bcc

Subject Re: Patent Application Entitled "Novel Eyewear" - BASF

Fernando,

Hi. I've gone over the materials and I'm surprised that the examiner doesn't see the very clear differences between what we are trying to patent versus the claims awarded to Wargon.

Here's my layman's take on the examiners' arguments...

**REDACTED - ATTORNEY-CLIENT PRIVILEGED INFORMATION**

Do you need more information from me?

Thanks,

Tel (810) 397-1429  
Fax (208) 485-0546  
Web [www.industry-scope.com](http://www.industry-scope.com)

```
> From: Fernando A Borrego <borregf@basf-corp.com>
> Date: Wed, 12 Jan 2005 15:14:36 -0500
> To: <mbleau@industry-scope.com>
> Subject: Patent Application Entitled "Novel Eyewear"
>
> Mike,
> Here is the first installment of open issues we currently have. The
> attached file represents the complete US Patent and Trademark Office
> (USPTO) file for the continuation-in-part application referenced above.
>
> (See attached file: MB-1-CIP File History 12Jan05.pdf)
>
> We need to formulate a response to the USPTO Examiner's rejection of the
> claims in the application (see pages 2 and 3 of the USPTO Non-Final
> Rejection) by January 20, 2005 (additional extensions of time are
> available, if needed). The reference cited against your application is
> provided herein for your convenience.
>
> (See attached file: us5949514 0 716.pdf)
```

> Feel free to contact me if you have any questions or concerns.



> Best regards,  
>  
> Fernando  
> 734-324-6193 (Telephone)  
> 734-324-6823 (Facsimile)  
> 313-300-8078 (Cell)  
> borregf@basf.com  
>



## ATTACHMENT B

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

## NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 06/28/2005  
Fernando A. Borrego, Esq.  
1238 Balfour Road  
Grosse Pointe Park, MI 48230

RECEIVED

JUL - 5 2005

EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 06/28/2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/205,238	07/25/2002	Michael James Bleau	MB-1	6486

TITLE OF INVENTION: NOVEL EYEWEAR

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$300	\$1000	09/28/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

## I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.